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EXAMINER

ARYANPOUR, MITRA

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3711

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GROUP 3700

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/820,091
Filing Date: March 28, 2001
Appellant(s): NIMMONS, KENNETH W.

John C. Freeman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 25 June 2004.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 1, 14 and 19-31 are cancelled.

Claims 2-4, 7-11, 13-18, 32-40, 42, 43, 45-55 are rejected under 35 USC 103(a) for being obvious over Bartoli (5,000,447) in view of page 220 of "SPORTS - The Complete Visual Reference book (SPORTS)" and Motooka et al (5,584,133).

Claims 5, 6, 12, 41, 44 and 56 are rejected under 35 USC 103(a) as being unpatentable over the prior art of record as applied to claims 2, 9, 38 and 43 and further in view of Kennedy, III et al (6,200,239).

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

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(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that (I) claims 2-4, 7-11, 13, 15-18, 32-40, 42, 43 and 45-55 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8). Appellant further states that (II) claims 5, 12, 41, 44 and 56 stand or fall together.

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because claim 6 has been omitted.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,000,447	BARTOLI	3-1994
5,584,133	MOTOOKA et al.	12-1996
6,200,239	KENNEDY, III et al.	03-2001

SPORTS, The Complete Visual Reference, A Firefly Book, Published 2000, pages 220 and 221

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 2-4, 7-11, 13-18, 32-40, 42, 43, 45-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartoli (5,000,447) in view of page 220 of "SPORTS - The Complete Visual Reference book (SPORTS)" and Motooka et al (5,584,133).

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Regarding claim 7, Bartoli shows a deformable base for use during baseball comprising: a bottom, a top face, and a sidewall attached to the bottom and top face. Bartoli as disclosed above does not expressly disclose the inclusion of any form of identification label or indicia on the top and/or sides of the base. Providing identification label(s) on sports paraphernalia is old and conventional. The use of indicia is shown on page 220 of SPORTS. SPORTS shows a conventional baseball base comprising a bottom, a top face, and a sidewall attached to the bottom and top face, wherein the baseball base is provided with an identification label on the top center of the base. In view of SPORTS, it would have been obvious to have also included an identification label for the base of Bartoli, the motivation being so the Bartoli base can be assigned to a particular team, or it could be used for advertising a particular company Logo.

Bartoli as modified in view of SPORTS above, does not expressly disclose the method and means for applying or positioning the printed image/indicia on the base. As best seen in the figure, it appears that the indicia on the base of SPORTS is embossed or screen-printed, however, such is not readily disclosed. There are numerous methods available for applying printed images (indicia) on sports paraphernalia. A few examples are demonstrated by Motooka et al. Motooka et al shows a baseball catching implement having a name plate fitting of rubber or synthetic resin having elasticity affixed to a back member of the implement at any desired position, wherein the name plate fitting includes a frame member having a contour corresponding to that of a name plate. Further, relying on the well known teaching in the art provided in SPORTS to provide indicia on a base plate, it would have been obvious in view of Motooka et al to include a nameplate for holding indicia on the modified base of Bartoli, the

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motivation being so the indicia is readily interchanged in order to utilize the same base for a plurality of different teams or for showing advertisements from a variety of different companies.

Regarding claim 8, note the rejection of claim 7. With regards to the identification being positioned on the sidewall, it should be noted that the location or position of the identification label/indicia on a sports paraphernalia, in the instant case the baseball base, raises no criticality, the baseball would work equally well, regardless of where the identification label/indicia is positioned.

Regarding claims 2-4, note the rejection on lines 4-11 of claim 7.

Regarding claims 9-11, note the rejection of claim 8 and lines 4-11 of claim 7.

Regarding claim 13, Bartoli as modified above additionally shows the base to have second, third and fourth sidewalls (see figure 2) forming a square and being attached to the top and bottom face (best shown in figure 1).

Regarding claim 15, Bartoli as modified above additionally shows a post (8) attached to the bottom face of the base.

Regarding claim 16, Bartoli as modified above further shows a plate (10) attached to the post (8); and wherein the combination of the plate and post are embedded into the bottom face of the base. Note: When the combined assembly (plate and post) is embedded in the bottom face, it inherently creates a lip section so that a portion of the plate is securely held on the bottom face (see column 3, lines 1-9).

Regarding claims 17 and 18, Bartoli as modified above additionally shows the base to be made of a resiliently deformable material such as rubber (See column 2, lines 54-61).

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Regarding claims 32 -34, note the rejection for claim 13. Bartoli and also SPORTS show the sidewalls of the base, to define a square-like shape.

Regarding claim 35, note the rejection for claim 16.

Regarding claims 36 and 37, note the rejection for claims 17 and 18.

Regarding claims 38-40, note the rejection for claims 2-4.

Regarding claim 42, note the rejection of claim 7, lines 4-11.

Regarding claim 43, note the rejection of claim 8.

Regarding claim 45, note the rejection for claim 15.

Regarding claim 46, note the rejection for claim 16.

Regarding claims 47 and 48, note the rejection for claims 17 and 18.

Regarding claim 49, note the rejection for claim 15.

Regarding claim 50, note the rejection for claim 16.

Regarding claims 51 and 52, note the rejection for claims 17 and 18.

Regarding claims 53-55, note the rejection for claims 2-4.

Claims 5, 6, 12, 41, 44 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art of record as applied to claims 2, 9, 38 and 43 and further in view of Kennedy, III et al (6,200,239).

Regarding claim 5, as stated above, Bartoli does not disclose expressly the use of indicia on the baseball base. SPORTS shows it is well known to provide indicia on a baseball base. SPORTS does not expressly disclose the particular method for applying indicia on the base. As best seen in the figure, it appears that the indicia on the base of SPORTS is embossed or screen-

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printed. Customarily the embossed or screen-printed indicia/printed image is covered with a protective coating, however, such is not readily disclosed. The Motooka et al reference additionally, shows a baseball paraphernalia, in the instant case a baseball catching implement having a name plate positioned in a cutout, the cutout may be covered with a plate or film of transparent resin for protecting the name plate (10), wherein the name plate may be secured at any desired position on the catching implement (see discussion above). It should be noted: a film of transparent resin is considered an art recognized equivalent to a transparent polymer coating. Nonetheless, for the sake of argument, Kennedy, III et al. shows a sports ball, disclosing various methods of applying indicia in the form of a logo on a sports ball. One suggested method is a pressure sensitive hot melt adhesive, and another is a pressure sensitive adhesive, and alternatively applying a transparent polymer over the indicia for protective purposes (see column 4, lines 29-67). In view of Kennedy, III et al, it would have been obvious to one of ordinary skill in the art to include a coating on the modified base of Bartoli, the motivation being to protect the indicia from contamination.

Regarding claim 6, Bartoli as modified above does not expressly disclose the specific means for applying the indication means on a baseball base. As best seen in the figure, it appears that the indicia on the base of SPORTS is embossed or screen-printed, however, such is not readily disclosed. The Examiner takes Official Notice that there are many well-known means and methods of applying indicia on a sports paraphernalia. One well-known method is releasably printing the image on paper or fabric and then applying it to the desired surface either by pressure, heat or a combination of the aforementioned. Therefore, it would have been obvious to

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apply indicia for the modified base of Bartoli by using screen-printing, the motivation being to make the process of applying indicia more economical.

Regarding claim 12, note the rejection for claim 5.

Regarding claim 41, note the rejection for claim 5.

Regarding claim 44, note the rejection for claim 5.

Regarding claim 56, see the comments for claim 5.

(11) *Response to Argument*

For the above reasons, it is believed that the rejections should be sustained.

It should be noted: Claims 13 and 32 were objected to in the Final Office Action, because it was unclear if Appellant had chosen to cancel or amend claim 13, since on page 1 of the amendment filed 1/17/2003, Appellant has requested to do both. Claim 32 is dependent on claim 13. Nevertheless, claim 13 has been treated as an amended claim.

With regards to Appellant's arguments that neither Bartoli nor SPORTS disclose or suggest a cutout in the top face or a sidewall. Appellant's remarks are not understood, since neither the Bartoli nor the SPORTS reference have been used to show a cutout. The Bartoli reference has been used to show the claimed base structure (claims 7, 8, 13, 15-18, 32-37, 42, 43, 45-52). Although The SPORTS base alone, meets the structural limitations of the claimed base of claims 7, 8, 13, 32, 33, 34, 42 and 43), nevertheless, it was used to show indicia on the top surface a conventional baseball base. The Motooka et al and the Kennedy, III et al references show cutouts in the sports paraphernalia. The term "cutout" was not explicitly used in the claim rejections, since this feature is clearly shown in the figures, no further explanation was deemed necessary by the Examiner (see figure 2 of Motooka et al; and/or figure 5 of Kennedy, III et al).

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It should be noted that in the application as filed, Appellant merely refers to a "cutout 80" without providing any specific explanation as to how this "cutout" is produced. Furthermore, Appellant has failed to show in the drawings a "cutout" or the particular structure associated with the claimed "cutout". The broadest reasonable interpretation of a cutout would include the recessed area surrounding the indicia of the base of SPORTS.

With regards to Appellant's argument that *Motooka et al* and *Kennedy, III et al* are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, *Motooka et al* teaches applying a removable identification plate on a ball catching implement. *Motooka et al* reference shows means of personalizing a baseball paraphernalia, in the present instant it is considered to be relevant art, since applicant is also applying identification label to personalize a baseball base. In the case of *Kennedy, III et al*, again the reference teaches various means of applying indicia on a sports paraphernalia (a basketball). Both prior art references clearly demonstrate the use of personalized identification label on sports objects and various means and methods of applying and protecting the indicia. There is nothing new or unobvious about personalizing sports paraphernalia. Furthermore there is nothing unobvious about utilizing various well-known means for applying identification labels (indicia) on sports paraphernalia. It appears that Appellant has also reiterated this point in his remarks under section V. Summary of Invention of the Appeal Brief (page 7, lines 16-22 and page 8, lines 1 and 2). It further appears that Appellant's objective is to provide "a collector's item" for a special sporting event, such as

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the opening of a new stadium or a closing of a stadium . . . It is unclear how Appellant contends, that Motooka et al is nonanalogous art, since it is clearly directed to a baseball glove and can also considered "a collector's item".

With regards to Appellant's remark on "improving bases" (see pages 10 and 11), Appellant's remarks are not understood. Since it is unclear, how the structure of a base has been improved when adding "indicia" on the top or sides of a base? As Appellant has repeatedly stated, Appellant's intention is to provide "a collector's item" for a special sporting event, such as the opening of a new stadium or a closing of a stadium . . . (page 7, lines 16-22 and page 8, lines 1 and 2). Personalizing, in the instant case providing indicia on a known sports paraphernalia is not considered an improvement to the existing structure, especially since the structure is clearly capable of performing its intended use, with or without the "personalization". As Appellant has suggested (see pages 6 and 7, 3rd paragraph respectively), the indicia can be retrofitted on an existing base. SPORTS, Motooka et al and the Kennedy III, et al references show various ways of identifying a sports paraphernalia e.g. manufacture name, team logo, player number etc. all are considered as means to identify, hence indicia.

The Bartoli reference shows the structure of the claimed base. The SPORTS base shows a conventional base having indicia. From the figures, it is not expressly clear if the SPORTS base has a means for attachment to the ground i.e. stake or post. It is also not expressly clear the method of applying the indicia on t

he base of SPORTS. The Motooka et al and the Kennedy, III et al references have been used to show that indicia can be applied on a sport paraphernalia using various well known methods. The methods claimed by applicant, image printing i.e. screen print, recessed label with

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protective coating are well known means of applying indicia on various types of elements including sport paraphernalia. It should be noted, differences between Appellant's base and prior art base that reside in meaning and information conveyed by printed matter would not be patentable differences. Es Parte Breslow 192 USPQ 431.

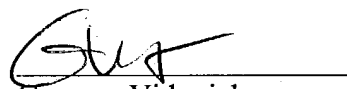
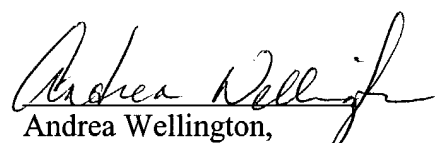
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Respectfully submitted,


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